

REMARKS

This request for reconsideration is filed in response to the Office Action dated July 23, 2009. In view of these remarks, this application should be allowed and the case passed to issue.

Claims 2-10 are pending in this application. Claims 2-10 have been rejected. Claim 1 was previously canceled.

Claim Rejections Under 35 U.S.C. § 112

Claim 7 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because it is not clear what a “W-type” cage is. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

In view of Fig. 4 and page 8, lines 13-15 of the specification, it is clear what is meant by “wavy-shaped.” Clearly, it means that the cage is shaped like a wave. Fig. 4 clearly depicts a substantially square-shaped wave. Claims “must be read in view of the specification, of which they are a part.” *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).

Claim Rejections Under 35 U.S.C. § 103

Claims 2-5 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ikezawa et al. (US 5,630,668) in view of Pitner (US 3,163,478). The Examiner asserted that Ikezawa et al. disclose a thrust needle bearing employing lubricating oil having a rolling element held by a cage wherein the arithmetic average roughness Ra of the rolling element set to at least 0.3 micrometers and at most 0.15 micrometers. The Examiner acknowledged that Ikezawa et al. do not disclose a range for the clearance.

Claims 6, 7, 9, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pitner (US 3,163,478). The Examiner averred that Pitner discloses a thrust needle bearing employing lubricating oil and having a rolling element (10) held by a cage (2) wherein a

clearance exists between a pocket guide face of the cage and rolling element. The Examiner acknowledged that Pitner does not disclose a range for the clearance, but maintained that it would have been obvious to select a clearance within the claimed range for the desired purpose of allowing a lubricating wedge of oil to achieve the desired lubricating characteristics.

These rejections are traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the invention, as claimed, and the cited prior art.

Pitner and Ikezawa et al., whether taken in combination, or taken alone, do not suggest the claimed thrust needle bearings because Pitner and Ikezawa et al. do not suggest the clearance between a pocket guide face of the cage and the rolling element is set to at least 60 μm and at most 130 μm , as required by claims 6 and 8; and the value of the arithmetic average roughness R_a of the rolling element is set to at least 0.03 μm and at most 0.15 μm , as required by claim 8.

Furthermore, the cited references do not suggest the unexpected improvement in depth of wear of roller, 10 % life, and life ratio, provided by thrust needle bearings according to the present invention, as shown in Tables 3 and 4 of the specification. In fact, the results achieved by the present invention are counterintuitive because the present invention is superior to thrust needle bearings having smoother surfaces! Further as regards claim 8, the cited prior art does not suggest the synergy achieved by the combination of the claimed rolling element smoothness and clearance between a pocket guide face of the cage, as explained in the specification on pages 8 and 9.

Pitner fails to disclose that a clearance between a pocket guide face and a rolling element is set in the range of 60-130 μm . In addition, setting the clearance in the range of 60-130 μm to provide a roller with a reduced depth of wear and improved life was discovered by the present

inventors through the experiments shown in Tables 3 and 4. Such improvements were discovered by the present inventors, and there is no suggestion of such improvements, experiments, and analyses by Pitner and Ikezawa et al. Hence, one of ordinary skill would not have arrived at the present invention in view of Pitner and Ikezawa et al., and it would clearly not have been just a matter of design choice to set the clearance in the range of 60-130 μm .

The Examiner alleged that Applicants' arguments filed April 23, 2009 have been fully considered. However, the Examiner did not address the arguments previously presented concerning the data in Tables 3 and 4, regarding unexpected results. The Examiner did not point out any deficiencies in the arguments. Thus, it appears the Examiner has not considered the evidence in Tables 3 and 4. The Examiner's apparent refusal to either review Applicants' evidence or explain why Applicants' evidence is insufficient is strongly traversed, as it violates Applicant's right to due process. Furthermore, the Examiner's failure to comment on the evidence presented is unnecessarily prolonging prosecution in this application.

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). There is no suggestion in Pitner or Ikezawa et al. to modify a thrust needle bearing to provide a clearance between a pocket guide face of the cage and the rolling element set to at least 60 μm and at most 130 μm , as required by claims 6 and 8; and the value of the arithmetic average roughness Ra of the rolling element set to at least 0.03 μm and at most 0.15 μm , as required by claim 8.

The only teaching of the claimed thrust needle bearings is found in Applicant's disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner's unsupported, conclusory assertions are not sufficient to establish a prima facie case of obviousness.

In view of the above remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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